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EXAMINER

FIELDS, BENJAMIN S

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/647,849
Filing Date: August 25, 2003
Appellant(s): HADFIELD, CINDY

R. William Graham (Reg. No. 33,891)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 24 July 2008 appealing from the Office action mailed 24 January 2008.

(1) Real Party of Interest

A statement identifying by name the real party of interest is contained in the brief.

(2) Related Appeals and Interferences

The Examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2003/0074315	Lam	4-2003
Deluxe	www.deluxe.com	1-1996

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lam (US PG Pub. No. 2003/0074315), [hereinafter Lam] in view of Deluxe (www.deluxe.com), [hereinafter Deluxe].

Referring to Claim 1: Lam teaches an Internet-based check ordering and reordering system, including: a client computer system; an Internet-based server having a check order entry user interface remote from and in operable communication with said client computer system (Lam: Abstract; Figures 1-3, #14; Page 2, Paragraphs 0031-0034//Lam shows an Internet-based check system consisting of a client terminal//), wherein said Internet-based server includes software for enabling input at said interface of client data (Lam: Figure 10; Page 6, Paragraph 0061//Lam teaches a system which uses a Internet-based server in order to enable receipt of input at the client terminal device//), and a printing station in operable communication with said Internet-based server computer system to print checks bearing said data thereon (Lam: Abstract; Page

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1, Paragraphs 0002, 0006-0011, 0014//Lam discloses a system which prints checks to remote locations//).

Lam, however, does not expressly teach an Internet-based check *ordering* and reordering system, including: client check number data, client bank transit number data including bank branch name, address and branch number, client bank account data, and client bank routing data at said check order user interface and has means for transmitting said bank client bank transit number data, said client bank account data, and said client bank routing data in an encrypted manner; a bank transit number computer system remote from and in operable communication with the Internet-based server computer system having software for receiving at least said client bank transit number data, said client bank account data, and said client bank routing data from said Internet-based server and de-encrypting said client bank transit number data, said client bank account data, and said client bank routing data, and comparing at least said client bank transit number data with a data listing corresponding to transit number data for a plurality of banks within a database of said bank transit number computer system to verify that said client bank transit number corresponds to bank transit data in said database, and transmits to said Internet- based server verified check print data which includes said client bank transit number data, said client bank account data, and said client bank routing data and a predetermined printing orientation.

Deluxe, in a similar environment, discusses an Internet-based check *ordering* and reordering system, including: client check number data, client bank transit number data including bank branch name, address and branch number, client bank account

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data, and client bank routing data at said check order user interface and has means for transmitting said bank client bank transit number data, said client bank account data, and said client bank routing data in an encrypted manner (Deluxe: Pages I – IV//Deluxe displays a system which allows a user to input a check number associated with a check and financial banking institution as well as account/routing information affiliated with a users account//); a bank transit number computer system remote from and in operable communication with the Internet-based server computer system having software for receiving at least said client bank transit number data, said client bank account data, and said client bank routing data from said Internet-based server and de-encrypting said client bank transit number data, said client bank account data, and said client bank routing data, and comparing at least said client bank transit number data with a data listing corresponding to transit number data for a plurality of banks within a database of said bank transit number computer system to verify that said client bank transit number corresponds to bank transit data in said database (Deluxe: Page II//Deluxe displays a system which employs a terminal unit in order for a user to enter associated account information and performs a verification procedure to verify user//), and transmits to said Internet- based server verified check print data which includes said client bank transit number data, said client bank account data, and said client bank routing data and a predetermined printing orientation; and a blank amount field (Deluxe: Pages I – IV//Upon complete system transaction, a user is able to print the checks as requested//).

At the time of invention it would have been obvious to modify the method of Lam by incorporating a feature for ordering and reordering checks with the invention of

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Deluxe in order to effectively create an online Internet-based check ordering and reordering system as disclosed for the purpose of increasing customer access to personal checks, etc. (Deluxe: Pages I – III).

Furthermore, the Examiner notes the disclosure of Lam as being a check ordering and reordering system and method wherein the *reordering* segment is inherent and well known. *Reordering* a check is done each time another check is ordered (hence, *reordering*) [See *In re Harza MPEP2144.04.VI.B*]. A system as such would additionally inherently possess checks; checks, with data that would consist of a bank branch name, a bank address, a bank branch number, and a blank amount field on the check.

Referring to Claim 2: Deluxe discusses the limitations as set forth in Claim 1.

Deluxe, however, does not explicitly show an Internet-based check ordering and reordering system, wherein software on said Internet-based server includes means for billing a client at said user interface using said system.

Lam discusses an Internet-based check ordering and reordering system, wherein software on said Internet-based server includes means for billing a client at said user interface using said system (Lam: Figure 8; Page 2, Paragraph 0017; Page 3, Paragraph 0037; Page 6, Paragraph 0065//Lam shows an Internet-based check server and system where a user is provided with a billing interface//).

At the time of invention it would have been obvious to modify the method of Lam by incorporating a feature for ordering and reordering checks with the invention of Deluxe in order to effectively create an online Internet-based check ordering and

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reordering system as disclosed for the purpose of increasing customer access to personal checks, etc. (Deluxe: Pages I – III).

Referring to Claim 3: Deluxe teaches the limitations as set forth in Claim 1.

Deluxe, however, does not expressly show an Internet-based check ordering and reordering system, wherein said Internet-based server is operably associated with a database which contains and stores said client data, said client check number data, said client bank transit number data, said client bank account data and said client bank routing data.

Lam, in a similar environment, expressly states and shows an Internet-based check ordering and reordering system, wherein said Internet-based server is operably associated with a database which contains and stores said client data, said client check number data, said client bank transit number data, said client bank account data and said client bank routing data (Lam: Figures 1-3; Claim 10//Lam shows an Internet-based check system which utilizes a server in conjunction with a database that stores information related to client [user] information//).

At the time of invention it would have been obvious to modify the method of Lam by incorporating a feature for ordering and reordering checks with the invention of Deluxe in order to effectively create an online Internet-based check ordering and reordering system as disclosed for the purpose of increasing customer access to personal checks, etc. (Deluxe: Pages I – III).

Referring to Claim 4: Deluxe discloses the limitations as set forth in Claim 1.

Deluxe, however, does not expressly disclose an Internet-based check ordering and reordering system, wherein said Internet-based server is further equipped to associate and store said received verified check information data from said bank transit number computer system with said client data, said client check number data, said client bank transit number data, said client bank account data and said client bank routing data.

Lam teaches an Internet-based check ordering and reordering system, wherein said Internet-based server is further equipped to associate and store said received verified check information data from said bank transit number computer system with said client data, said client check number data, said client bank transit number data, said client bank account data and said client bank routing data (Lam: Claims 1-10//Lam describes an Internet-based system where the Internet-based server is capable of associating user check information data//).

At the time of invention it would have been obvious to modify the method of Lam by incorporating a feature for ordering and reordering checks with the invention of Deluxe in order to effectively create an online Internet-based check ordering and reordering system as disclosed for the purpose of increasing customer access to personal checks, etc. (Deluxe: Pages I – III).

Referring to Claim 5: Deluxe discloses the limitations as set forth in Claim 1.

Deluxe, however, does not expressly teach an Internet-based check ordering and reordering system, wherein said printing station includes a computer which is operably connected to said Internet-based server in a manner to receive said client data, said

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client check number data, said client bank transit number data, said client bank account data, said client bank routing data and said verified check print data in an encrypted form and de-encrypts said data to enable printing of said checks.

Lam, in a similar environment, shows an Internet-based check ordering and reordering system, wherein said printing station includes a computer which is operably connected to said Internet-based server in a manner to receive said client data, said client check number data, said client bank transit number data, said client bank account data, said client bank routing data and said verified check print data in an encrypted form and de-encrypts said data to enable printing of said checks (Lam: Abstract; Page 1, Paragraphs 0002, 0006-0011, 0014//Lam discloses an Internet-based check system connected in a manner for reception of client data//).

At the time of invention it would have been obvious to modify the method of Lam by incorporating a feature for ordering and reordering checks with the invention of Deluxe in order to effectively create an online Internet-based check ordering and reordering system as disclosed for the purpose of increasing customer access to personal checks, etc. (Deluxe: Pages I – III).

(10) Response to Argument

Appellants argue:

1. The examiner acknowledged that neither reference teaches, suggests, or discloses the claimed invention. Rather, the combination is submitted as a means of rendering obvious the claimed invention. To this end, the examiner provides a screenshot of a Deluxe web site in combination with the teaching of Lam. Applicant

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respectfully submits that neither reference alone or in combination with the other teaches, suggests or discloses the invention. Lam simply discloses a system and apparatus for remotely printing certified documents. Particularly, Lam teaches a communication system for remotely and securely printing certified checks via the Internet and includes a customer communication device operative to initiate communication with a web server which is in communication with a system bank capable of creating an image file of the certified check which is securely encrypted and transmitted back to the customer via the Internet. Lam prints a "certified check" from a bank at a site remote to the bank wherein the remote site must have respective printing apparatus 15 (FIGS. 2 and 3) capable of printing certified documents. An encrypted image file of the requested certified check will be received at the customer location and printed using bank specified printer on pre-numbered check paper, which is issued by the bank and securely stored in the printer. This in no way teaches the claimed invention. Also, the cited screenshot of Deluxe appears to teach no more than what was known prior to the claimed invention. That is, Deluxe, provides a site to facilitate the order of checks by partnered relationships with financial institutions. This is similar to a middle man operation wherein local printers are affiliated with the banks and perform the printing of checks for a particular bank and the web site appears to do no more than facilitating this. Notably missing from the cited reference(s) is any teaching, disclosure or suggestion of the ability for obtaining local bank information, address, branch number in addition to the other bank and client information. Also missing is the element of the instant invention which compares at least the client bank transit number data with a data listing corresponding to transit number data for a plurality of banks within a database of the bank transit number computer system to verify that the client bank transit number corresponds to bank transit data in the database (i.e., the database being federally provided). This information is required in the instant invention in order to perform a validation and goes to the heart of the instant invention. By so providing, there is not only a reduced chance of misinformation but also a mechanism in which to more securely and accurately speed the process of check ordering and reordering. Further, there is provided a mechanism by which to reduce printing costs through reduced

printing error and increased competition local printers. Currently, local banks have established relationships with a printer and govern the cost of check book reorders through these relatively noncompetitive relationships.

1. The Examiner does not find this argument to be persuasive and discusses the argument in detail below:

The Examiner notes that the Lam reference does in fact provide *the ability* for obtaining local bank information, address, branch number in addition to the other bank and client information at least at Figure 10; Page 1, Paragraph 0011-Page 2, Paragraph 0019; Page 3, Paragraph 0041-Page 4, Paragraph 0043; Page 5, Paragraph 0049; Page 6, Paragraphs 0061-0062; Page 7, Paragraphs 0069-0070; See Claims 1 and 4. Particularly, the element which compares at least the client bank transit number data with a data listing corresponding to transit number data for a plurality of banks within a database of the bank transit number computer system to verify that the client bank transit number corresponds to bank transit data in the database (i.e., the database being federally provided) for the purpose of performing a validation that is taught by the Lam reference at least at Page 3, Paragraph 0041-Page 4, Paragraph 0043; Page 5, Paragraph 0049; Page 6, Paragraphs 0061-0062; Page 7, Paragraphs 0069-0070; See Claims 1 and 4 and thus parallels the instant invention. The Deluxe reference shows that it provides the ability for obtaining local bank information, address, branch number in addition to the other bank and client information in the manner shown on the front page of the site. In regards comparing at least the client bank transit number data with a data listing corresponding to transit number data for a plurality of banks within a database of the bank transit number computer system to verify that the client bank

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transit number corresponds to bank transit data in the database (i.e., the database being federally provided) for the purpose of performing a validation, this is an old, common, and well known technique within the financial market.

Appellants argue:

2. None of the prior art provides the claimed elements of the instant invention. The references fail to teach the instant invention and it is a great leap to imply that the combination of references teach this. There is simply no discussion, disclosure, suggestion or teaching whatsoever to do so, absent the instant invention. It is recognized that the nonobviousness requirement extends the field of unpatentable material beyond that which is known to the public under § 102, to include that which could readily be deduced from publicly available material by a person of ordinary skill in the pertinent field of endeavor. See *Graham*, 383 U.S., at 15, 86 S. Ct., at 692. As noted in 550 U. S. ___ (2007), Opinion of the Court... SUPREME COURT OF THE UNITED STATES. No. 04-1350. KSR INTERNATIONAL CO., PETITIONER v. TELEFLEX INC., the Federal Circuit's so-called "teaching-suggestion-motivation" standard for obviousness is also a helpful though not determinative test, wherein there must be some motivation or suggestion to combine specific prior art in such a way as to arrive at the particular combination disclosed in the patent at issue. See, e.g., *Ecolchem Inc. v. Southern California Edison Co.*, 227 F.3d 1361, 1372 (Fed. Cir. 2000), cert. denied, 532 U.S. 974 (2001) *Ashland Oil*, 776 F.2d at 293, and that teaching- suggestion-motivation cannot come from the invention, i.e., prevention of hindsight use. The issue is here is whether Lam and/or Deluxe and some other knowledge (presumably the Examiner's) brought here together renders obvious claimed invention. The Federal Circuit has followed the Court's holding in *Adams*. See, e.g., *Kahn v. General Motors Corp.*, 135 F.3d 1472, 1479-80 (Fed. Cir. 1998), cert. denied, 525 U.S. 875 (1998) ("In determining obviousness, the invention must be considered as a whole."). Set aside Lam and Deluxe which Applicant asserts do not teach the invention, no other evidence has been put forth which teach, suggest or disclose the invention. Combining the references

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does no more than provide separate technologies which enable a user to order and/or reorder personal and business checks on the aforementioned manner.

2. The Examiner does not find this argument to be persuasive and discusses the argument in detail below:

The Examiner will place focus on the Appellants comment: "The issue is here is whether Lam and/or Deluxe and some other knowledge (presumably the Examiner's) brought here together renders obvious claimed invention. The Federal Circuit has followed the Court's holding in Adams. See, e.g., Kahn v. General Motors Corp., 135 F.3d 1472, 1479-80 (Fed. Cir. 1998), cert. denied, 525 U.S. 875 (1998) ("In determining obviousness, the invention must be considered as a whole."). Set aside Lam and Deluxe which Applicant asserts do not teach the invention, no other evidence has been put forth which teach, suggest or disclose the invention. Combining the references does no more than provide separate technologies which enable a user to order and/or reorder personal and business checks on the aforementioned manner."

Furthermore, the Examiner has included a chart below which better discloses the portions of the references which have been relied upon within the rejection on appeal in efforts to further **"provide a claim construction for the claim language at issue"**.

CLAIM & LIMITATION	REFERENCE # 1	REFERENCE # 2
	Lam (2003/0074315)	Deluxe (www.deluxe.com)
	teaches this limitation at:	teaches this limitation at:
1		
an Internet-based check ordering and reordering system, including: a client computer system; an Internet-based server having a check order entry user interface remote from and in operable communication with said	Abstract; Figs. 1-3(#14),10; Pg 1, Pars. 2,6-11,14; Pg 2, Para. 31-34; Pg 6, Para. 61; See Claims 1,4	NOT RELIED UPON TO TEACH THIS LIMITATION

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client computer system, wherein said Internet-based server includes software for enabling input at said interface of client data, and a printing station in operable communication with said Internet-based server computer system to print checks bearing said data thereon		
client check number data, client bank transit number data including bank branch name, address and branch number, client bank account data, and client bank routing data at said check order user interface and has means for transmitting said bank client bank transit number data, said client bank account data, and said client bank routing data in an encrypted manner; a bank transit number computer system remote from and in operable communication with the Internet-based server computer system having software for receiving at least said client bank transit number data, said client bank account data, and said client bank routing data from said Internet-based server and de-encrypting said client bank transit number data, said client bank account data, and said client bank routing data, and comparing at least said client bank transit number data with a data listing corresponding to transit number data for a plurality of banks within a database of said bank transit number computer system	NOT RELIED UPON TO TEACH THIS LIMITATION	See Deluxe Site Page (www.deluxe.com); See Links to Other Subsystem Elements On the Site Page; consider old and well known check order/reorder techniques within the financial market;

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to verify that said client bank transit number corresponds to bank transit data in said database, and transmits to said Internet- based server verified check print data which includes said client bank transit number data, said client bank account data, and said client bank routing data and a predetermined printing orientation; and a blank amount field.		
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Appellants argue:

3. Applicant has adequately rebutted the examiner's contention. It is respectfully submitted that the cited art, namely, Lam and Deluxe, do not render obvious the instant invention, to produce the claimed present invention. Combining Lam with Deluxe's teachings is not intuitive nor does it make sense or render the present invention as it is not understood why one would combine such teachings as they perform completely different tasks, i.e., Lam to send a single certified check to conduct a transaction such as a purchasing real estate verses Deluxe as a facilitator to reordering checks through the person's bank. The differences between the prior art and claimed invention are very apparent. The level of ordinary skill in the art in the field of check book fulfillment has not been established and cannot be asserted without some reasonable basis for doing so. Claims 1-5 are respectfully submitted to be patentably distinct over the cited art. Withdrawal of the rejection of claims 1-5 is kindly requested.

3. The Examiner does not find this argument to be persuasive and discusses the argument in detail below:

The Examiner notes, as mentioned supra that the Lam reference does in fact *suggest the ability* for obtaining local bank information, address, branch number in addition to the other bank and client information at least at Figure 10; Page 1,

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Paragraph 0011-Page 2, Paragraph 0019; Page 3, Paragraph 0041-Page 4, Paragraph 0043; Page 5, Paragraph 0049; Page 6, Paragraphs 0061-0062; Page 7, Paragraphs 0069-0070; See Claims 1 and 4. Particularly, the element which compares at least the client bank transit number data with a data listing corresponding to transit number data for a plurality of banks within a database of the bank transit number computer system to verify that the client bank transit number corresponds to bank transit data in the database (i.e., the database being federally provided) for the purpose of performing a validation is taught by the Lam reference at least at Page 3, Paragraph 0041-Page 4, Paragraph 0043; Page 5, Paragraph 0049; Page 6, Paragraphs 0061-0062; Page 7, Paragraphs 0069-0070; See Claims 1 and 4 and thus parallels the instant invention. The Deluxe reference shows suggest the ability for obtaining local bank information, address, branch number in addition to the other bank and client information at least in the manner shown on the front page of the site. In regards comparing at least the client bank transit number data with a data listing corresponding to transit number data for a plurality of banks within a database of the bank transit number computer system to verify that the client bank transit number corresponds to bank transit data in the database (i.e., the database being federally provided) for the purpose of performing a validation, this is an old, common, and well known technique within the financial market.

Focusing on the chart shown above, it is clear where each reference teaches and fails to expressly discuss the elements taught within the instant application.

Furthermore, it can be understood that one would combine the teachings of Lam and Deluxe as they perform similar tasks, i.e., Lam to send a single certified check

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order/reorder system and Deluxe as a facilitator to reordering checks for the purpose of allowing and possibly increasing a customer's access to personal checks, etc. (See Deluxe:www.deluxe.com). Thus, the level of ordinary skill in the art has been established.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/BENJAMIN S. FIELDS/
Patent Examiner, Art Unit 3692

Conferees:

Vincent Millin /VM/
Patent Appeals Specialist

Kambiz Abdi /K.A./
Supervisory Patent Examiner, Art Unit 3692/
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